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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,637	11/16/2000	Kouichi Matsuda	203828US6	5346

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

NGUYEN, CAO H

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 10/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/714,637

Applicant(s)

Matsuda

Examiner

Cao (Kevin) Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Aug 1, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20, and 21 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20, and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. Claim 15 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Liles et al. US Patent Number 5,880, 731, hereinafter referred to as Liles. Liles teaches a conversation support method and program storage medium for receiving a request for sending a message from an avatar, determining whether a destination of the message exists in shared virtual space and execution the connection processing in accordance with a decision made by a determining step as shown in Figure 12 and as described in Col. 12, lines 31-51, where shared virtual space can be interpreted as the proximity radius and the step of determining the destination is in a shared virtual space is made in step 234. Finally, Liles teaches about execution connection processing in accordance to a decision made by a determining step as seen in reference #236, 236, and 240.

Claim Rejections - 35 USC § 103

2. Claim 1-4 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy et al., US Patent Number 6,219,045, hereinafter referred to as Leahy, and Linnett et al., US Patent Number 5,682,469, hereinafter referred to as Linnett. Regarding claims 1 and 8, Leahy teaches a conversation support system, method, and computer program with means for enrolling an avatar of a log-in user into a shared virtual space as disclosed in the abstract and as well as Col. 14, lines 17-28, where Leahy teaches an means for enrolling as an avatar of a log-in user into shared virtual space. Also, Leahy teaches a means for determining in response to a user's message

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or call, determining whether a the message's party original exists in the shared virtual space as well as a means to execute a connection process in accordance with a decision made by the said determination means. Leahy teaches this in Col. 4, line 59 to Col.5, line 14, Col. 11, lines 1-16 and Col. 11, where a user determines whether the message from the user originated from the shared virtual space and delivering the message to be display into a graphical display. However, while he teaches this he fails to explicitly teach that the determining and connecting means is imported to a virtual mobile telephone to each avatar in the shared virtual space for the determining and connecting means. Linnett, however, teaches a means for imparting a virtual mobile telephone to an avatar in a shared virtual space. Linnett teaches this as described in the abstract, where a personal avatar is generated for each user in assisting the user in using the computer, and he also teaches a virtual mobile telephone in the form of a cell phone used within the virtual space as described in Col. 13, lines 9-17 which can be used to speed dial or communicate with other people or possibly other users. It is all clear that the virtual mobile cell phone allows the user to contact other users. Thus, it would have been obvious to one of ordinary skill in the art to modify the virtual world chat client-server system of Leahy to include the virtual mobile telephone of Linnett in order to obtain a virtual world chat client-server system with a virtual mobile telephone. One of ordinary skill in the art would have been motivated to modify the virtual world chat client-server system of Leahy to include a virtual mobile telephone of Linnett in order to provide the user a convenient metaphor for the user to contact other users.

Regarding claims 3, 4, 10, and 11, Leahy and Linnett teach that that if the calling party originated the call from another telephone in another virtual space, a connecting means establishes a connection with the telephone in another virtual space and/or executes message transfer as described in Leahy, Col. 11, lines 10-16. It is clear that Leahy and Linnett teach a connecting means receives the call from the telephone in the telephone from another virtual space and connects the received call to the virtual mobile phone of the called avatar in the shared virtual space via server 61.

3. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy and Linnett. While Leahy and Linnett teach a conversation support system and method as described in claims 1 and 8 above, they fail to explicitly teach a system and method wherein if the calling party originated from a telephone in the real world, the connecting step establishes a connection with the calling party through a public telephone network in the real world. However, it is obvious to one of ordinary skill in the art that users may log into an online chat with avatar environment through any means to connect to the Internet, including public telephone network via a modem. Thus, it is clear that if the calling party calls from a telephone or modem in the real world, it is obvious that there exists a connecting step that establish the connection with the calling party through a public telephone network in the real world; the examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art would to modify the conversation support system and method of Leahy and Linnett to include the connecting step from a telephone over a public

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telephone network to connect a calling party, which is notoriously well known in the art, to obtain a conversation support system with a connecting step from a telephone over a public telephone network to connect a calling party. One of ordinary skill in the art would have been motivated to modify the conversation support system and method of Leahy and Linnett to include the connecting step from a telephone over a public telephone network to connect a calling party, which is notoriously well known in the art, in order to obtain a means to send a message from a calling party through conventional network to the Internet to facilitate online chat for users in an avatar system over the readily available connection means.

4. Claims 5-7, 12-14, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy, Linnett, and Smith, "Adding 3D Visualizations to GIS".

Regarding claims 5, 12, 18, and 19, Leahy teaches a conversation support system, method and computer program with means for enrolling an avatar of a log-in user into a shared virtual space as disclosed in the abstract and as well as Col. 14, lines 17-28, where Leahy teaches an means for enrolling as an avatar of a log-in user into shared virtual space. Also, Leahy teaches a means for determining in response to a user's message or call, determining whether a the message's party original exists in the shared virtual space as well as a means to execute a connection process in accordance with a decision made by the said determination means. Leahy teaches this in Col. 4, line 59 to Col.5, line 14, where a user determines whether the message from the user originated from the shared virtual space and delivering the message to be display into a graphical display. However, while he teaches this he fails to explicitly teach that the

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determining and connecting means is imported to a virtual a virtual mobile telephone to each avatar in the shared virtual space for the determining and connecting means.

Linnett, however, teaches a means for imparting a virtual telephone to an avatar in a shared virtual space. Linnett teaches this as described in the abstract, where a personal avatar is generated for each user in assisting the user in using the computer, and he also teaches a virtual mobile telephone in the form of a cell phone used within the virtual space as described in Col. 13, lines 9-17 which can be used to speed dial or communicate with other people or possibly other users. It is all clear that the virtual mobile cell phone allows the user to contact other users. However, while Smith teaches this, he fails to explicitly teach a virtual public telephone. However, Smith teaches a virtual mobile telephone as disclosed in his web page, "Adding 3D Visualization Capabilities to GIS". Here, Smith teaches telephone boxes in predetermined areas as seen in the lower and upper left figures on page 1 rendered in a 3D model of a VRML world as described on page 1, fifth paragraph. Thus, it would have been obvious to one of ordinary skill in the art to modify the virtual world chat client-server system with a virtual mobile telephone of Leahy and Linnett to include the public telephone of Smith in order to obtain a virtual world chat client-server system with a virtual public telephone. One of ordinary skill in the art would have been motivated to modify the virtual world chat client-server system of Leahy to include a virtual mobile telephone of Linnett in order to provide the user with natural real life manner to contact other users in an urban environment.

Regarding claims 7 and 14, Leahy, Linnett and Smith teach that that if the calling party originated the call from another telephone in another virtual space, a connecting means establishes a connection with the telephone in another virtual space and/or executes message transfer as described in Col. 11, lines 10-16 of Leahy. It is clear that Leahy, Linnett and Smith teach a connecting means receives the call from the telephone in the telephone from another virtual space and connects the received call to the virtual mobile phone of the called avatar in the shared virtual space.

Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy, Linnett, and Smith. While Leahy, Linnett, Smith teach a conversation support system and method as described in claims 5 and 12 above, they fail to explicitly teach a system and method wherein if the calling party originated from a telephone in the real world, the connecting step establishes a connection with the calling party through a public telephone network in the real world. However, it is obvious to one of ordinary skill in the art that users may log into an online chat with avatar environment through any means to connect to the Internet, including public telephone network via a modem. Thus, it is clear that if the calling party calls from a telephone or modem in the real world, it is obvious that there exists a connecting step that establish the connection with the calling party through a public telephone network in the real world; the examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art would to modify the conversation support system and method of Leahy, Linnett, and Smith to include the connecting step from a telephone over a public telephone network to connect a calling party, which is notoriously well known in the art,

to obtain a conversation support system with a connecting step from a telephone over a public telephone network to connect a calling party. One of ordinary skill in the art would have been motivated to modify the conversation support system and method of Leahy, Linnett, and Smith to include the connecting step from a telephone over a public telephone network to connect a calling party, which is notoriously well known in the art, in order to obtain a means to send a message from a calling party through conventional network to the Internet to facilitate online chat for users in an avatar system over the readily available connection means.

5. Claims 16, 17, and 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liles. Regarding claim 16, with respect to claim 15 above, Liles teaches a conversation support method for sending a message to an avatar, but he fails to explicitly teach if that if the destination of the message is found in the real world, the connecting step establishes connection with the destination through a public network in the real world. However, determining if the destination of the message is found in the real world, such as determining a computer's Internet protocol address or IP address to determine whether a message can be sent, and connecting the user's message to the destination to send a message through the a public telephone network such as a modem is notoriously well-known in the art and examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art to modify the avatar chat session system of Liles to include a way to determine if the destination is found in the real world and connecting through a public telephone network in the real world in order to obtain a avatar chat session where users can send

messages from the real world through a public telephone network. One of ordinary skill in the art would have been motivated to modify the avatar chat session system of Liles to include the real world message through a public telephone network in the real world in order determine whether a message could be sent to a computer in the real world to a person in a virtual world, such as a member of an online chat session.

Regarding claims 17 and 21, Liles teaches a method and program storage medium for receiving a request for sending a message, determining whether the destination is in a shared virtual space and if the step is affirmative, sending a message to the avatar, as disclosed in Figure 12 and described in Col. 12, lines 30-51. However, while he teaches this, he fails to explicitly teach receiving the request from a source in the real space through a public telephone network in the real world. However, sending a message such as a chat room or instant message over the Internet from a source in the real world (such as a user) through a public telephone network such as a modem is notoriously well known in the art and examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art to modify the avatar chat session system of Liles to include the real world message through a public telephone network in the real world to obtain a avatar chat session where users can send messages from the real world through a public telephone network. One of ordinary skill in the art would have been motivated to modify the avatar chat session system of Liles to include the real world message through a public telephone network in the real world in order to provide users of telephone modems to connect through phone

lines in order to exchange messages from the real world to a person in a virtual world, such as a member of an online chat session.

Response to Amendment

Applicant's arguments filed on 08/06/03 have been fully considered but they are not persuasive.

6. In response to applicant's argument on pages 11-12 that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Leahy teaches log-in user into a shared virtual space used in combination of Linnett's imparting virtual mobile telephone. One of ordinary skill in the art would have been motivated to modify the virtual world chat client-server system of Leahy to include a virtual mobile telephone of Linnett in order to provide the user a convenient metaphor for the user to contact other users.

On pages 13-14 of the Remark, Applicant argues that the combination of Leahy, Linnett and Smith fails to teach "phone box". However, the limitation as claimed set forth to read on Smith "the trees and phone boxes are rendered with small graphic textures on the geometric faces."

On page 15 of the Remark, Applicant argues that Liles fails to explicitly teach "proximity radius". However, the limitation as claimed set forth to reply upon Liles's "the participant's from whom message was received is outside the proximity radius will be "heard" or "seen" by the user (see col. 11-12, lines 1-67).

On pages 15-16 of the Remark, Applicant argues that the Liles fails to explicitly teach "receiving a request of sending a message from a telephone in a real world". Network such as a modem is notoriously well known in the art and examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art to modify the avatar chat session system of Liles to include the real world message through a public telephone network in the real world to obtain a avatar chat session where users can send messages from the real world through a public telephone network. One of ordinary skill in the art would have been motivated to modify the avatar chat session system of Liles to include the real world message through a public telephone network in the real world in order to provide users of telephone modems to connect through phone lines in order to exchange messages from the real world to a person in a virtual world, such as a member of an online chat session.

Accordingly, the claimed invention as represented in the claims does not represent a patentable distinction over the prior art of record.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach inventions where a user may contact other users if they are not within the shared virtual world space as well as inventions relating to virtual telephones.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Nguyen whose telephone number is 703-305-3972. The examiner can normally be reached on Monday - Friday 8 AM - 4:30 PM.

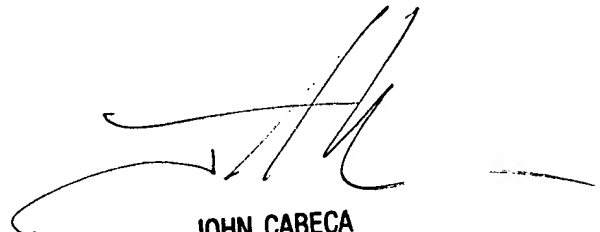
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on 703-308-3116. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

OK
October 17, 2003



JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100